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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,728	05/10/2006	Reinhold Klipper	CH8452/CHS31001	4461

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LANXESS CORPORATION  
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EXAMINER
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BARRY, CHESTER T

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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06/19/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,728	<b>Applicant(s)</b> KLIPPER ET AL.	
	<b>Examiner</b> CHESTER T. BARRY	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/2/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

Claims 1 – 7, 9 – 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, step (a), no standard by which the appropriateness of reacting a porogen is self-evident from claim 1 alone, nor is any clear standard provided by the specification. Accordingly, the metes and bounds of claim 1 is unclear given the difficulty in judging whether reacting a porogen is appropriate in any instance of practicing the invention defined by claim 1. See also claim 9 step (a).

Per claim 2, it is unclear whether “obtainable” is to be taken literally, or whether “obtained by” was intended, as in claim 9 line 3. In the first instance, the claim would read on an exchanger meeting the strictures of lines 1 and 2 provided it was capable of being obtained in the manner recited in the claim (even the particular material at issue were in fact obtained by a different method). In the second instance, for the claim to read on the material, the material at issue would have to have been made in the proscribed method.

Per claim 4, given the recital of “in particular,” it is unclear whether the claimed use is limited to the adsorption of heavy metals and noble metals, and their compounds, or whether the scope of the claim encompasses adsorption metals other than heavy metals and noble metals. Similarly, the recital of “in particular” at line 5 and at the penultimate line of claim 4.

Per claim 5, it is unclear whether all the listed metals must be adsorbed in a given practicing of the claimed method, or whether a Markush group was intended, e.g.,

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“wherein said heavy or noble metal is selected from the group consisting of mercury, iron, etc.

In claim 6, “metals which can be present . . .” is confusing because it is widely known that not all metals are in the +III oxidation state: Some, for example, are in the +I or +II state. It appears that applicants intended the claim to read, “in that metals ~~which~~ that are can be present . . .”

Per claims 15 and 19, it is unclear whether the phrase, “the elements of the platinum group . . . is removed” means that all elements belonging to the platinum group are removed from the fluid in the practice of the invention, or whether it is sufficient that one such element from that group be removed.

/Chester T. Barry/

Primary Examiner, Art Unit 1797

571-272-1152